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10/568,699	09/29/2006	Nicolaas A. De Munck	2003M091	7132
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EXXONMOBIL CHEMICAL COMPANY			EXAMINER	
5200 BAYWAY DRIVE			HEINCER, LIAM J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,699	<b>Applicant(s)</b> DE MUNCK ET AL.
	<b>Examiner</b> Liam J. Heincer	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 January 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.

4a) Of the above claim(s) 1-9 and 32-39 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 10-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1668)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ageishi et al. (5,880,310) in view of Schlosberg et al. (5,798,319).

Regarding claim 10, Ageishi et al. teaches a process for producing plasticizer esters comprising (Col. 1, lines 6-7) esterifying an acid or an anhydride (Col. 3, lines 27-28) with an alcohol containing from 6 to 13 carbon atoms to form a crude ester (Col. 3, lines 41-44) and then treating it with a base solution (Col. 3, lines 54-55). The crude ester is purified through a combination of fine filtration using a filter aid and adsorption treatment (Col. 5, lines 8-11).

Ageishi et al. does not teach filtering the crude ester to remove a liquid product and then stripping the liquid product before the purification steps. However, Schlosberg et al. does teach the filtration of solids from the ester mixture and then removal of excess alcohol by steam stripping before the final filtration (purifying) steps (Col. 6, lines

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1-5). Ageishi et al. and Schlosberg et al. are combinable because they are from the same field of endeavor, namely that of process for making plasticizer esters. At the time of the invention, a person of ordinary skill in the art would have found it obvious to include the steps of filtration of solids from the ester mixture and then removal of excess alcohol by steam stripping, as taught by Schlosberg et al., in the overall process, as taught by Ageishi et al., and would have been motivated to do so because an extra filtration step can enhance the purity of the plasticizer ester as well as enhancing its properties.

Regarding claims 11-12, Ageishi et al. additionally teaches that the base solution used in the process is an alkali metal salt, such as sodium hydroxide (Col. 6, lines 9-10).

Regarding claims 13-14, Ageishi et al. does not teach the process step of removing the water from the ester before the first filtering step by flashing or steam stripping. However, Schlosberg et al. does teach the removal of the water through heat and vacuum in a flash step (Col. 5, lines 66-67) before the first filtration. At the time of the invention, a person of ordinary skill in the art would have found it obvious to use the above step of removing the water before the first filtration, as taught by Schlosberg et al., in the overall process, as taught by Ageishi et al., and would have been motivated to do so in order to facilitate the ease of the first filtration step.

Regarding claims 15-16, Ageishi et al. additionally teaches that the acid or anhydride can be aromatic monocarboxylic acids or anhydrides and polybasic aromatic carboxylic acids and anhydrides, such as phthalic anhydride (Col. 3, lines 25-30).

Regarding claims 17-18, Ageishi et al. additionally teaches that the alcohol is a C<sub>9</sub> to C<sub>11</sub> alcohol, preferably a C<sub>10</sub> or C<sub>11</sub> alcohol (Col. 3, lines 40-45).

Regarding claim 19, Ageishi et al. does not teach that the adsorbent and the filter aid are used in amounts from about 0.01 to about 5 weight percent based on the weight of the ester. However, it is well known in the art to change result effective variables, such as the amounts of additives used in a process to make a composition (MPEP §2144.05). At the time of the invention, a person of ordinary skill in the art would have found it obvious to optimize the amount of adsorbent and filter aid used in the process

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to make a plasticizer ester through routine experiment, and would have been motivated to do so in order to determine the optimum amount of these additives needed to effect an efficient filtration to produce a plasticizer ester having the desired properties.

Regarding claim 20, Ageishi et al. additionally teaches that the final filtration can be performed by simultaneously conducting adsorption and filtration using a filter aid and an adsorbent (Col. 6, lines 55-60).

Regarding claim 21, Ageishi et al. does not teach that the mixture of filter aid and adsorbent used in the process is from about 90 to about 30 parts by weight of the filter aid and from about 10 to about 70 parts by weight of the adsorbent. However, it is well known in the art to change result effective variables, such as the amounts of additives used in a process to make a composition (MPEP §2144.05). At the time of the invention, a person of ordinary skill in the art would have found it obvious to optimize the amount of adsorbent and filter aid used in the process to make a plasticizer ester through routine experimentation, and would have been motivated to do so in order to determine the optimum amount of these additives needed to effect an efficient filtration to produce a plasticizer ester having the desired properties.

Regarding claim 22-25, Ageishi et al. additionally teaches that the adsorbent used can be activated carbon (Col. 5, lines 10-15). Ageishi et al. does not teach that the filter aid is a clay or that the adsorbent also acts as the filter aid. However, Schlosberg et al. does teach that the adsorbent/filter aid can be clay (Col. 5, lines 55-60). At the time of the invention, a person of ordinary skill in the art would have found it obvious to use clay as filter aid/adsorbent, as taught by Schlosberg et al., in the overall process, as taught by Ageishi et al., and would have been motivated to do so because it is a common filter aid/adsorbent used in these processes and it is a naturally occurring material which makes it more economical than other choices.

Regarding claims 26-27, Ageishi et al. additionally teaches that the adsorption temperature and the filtration temperature are generally between 30° C and 120° C (Col. 5, lines 40-45).

Regarding claim 28, Ageishi et al. additionally teaches that the adsorption temperature and the filtration temperature are generally between 30° C and 120° C

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(Col. 5, lines 40-45) and that the plasticizer is a C<sub>8</sub> to C<sub>13</sub> dialkyl phthalate (using the specified alcohols and phthalic anhydride will produce these) (Col. 3, lines 25-45).

Regarding claim 29, Ageishi et al. additionally teaches that the plasticizer ester is a di-alkyl phthalate (using the specified alcohols and phthalic anhydride will produce these) (Col. 3, lines 25-45).

The Office recognizes that all of the claimed effects and physical properties are not positively stated by the reference. However, the reference teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties would inherently be achieved by combining the disclosed ingredients. If it is applicant's position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the examiner's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects by combining only these ingredients.

Regarding claim 30, Ageishi et al. additionally teaches using this plasticizer to plasticize a vinyl chloride resin (Col. 1, lines 5-10).

Regarding claim 31, Ageishi et al. additionally teaches using this composition as an insulating material for things like a wire cable (Col. 1, lines 10-15).

#### ***Response to Arguments***

Applicant's arguments filed January 11, 2008 have been fully considered but they are not persuasive, because:

A) Applicants argument that the prior art references teach a stripping step prior to filtration is not persuasive. Although both Ageishi et al. and Schlosberg et al. do teach a stripping step before filtration, as applicant points out (arguments pages 2 and 3), there is nothing in the claim language that would prohibit the use of a stripping step. The claims are directed towards "a process for the production of a plasticiser ester comprising" (emphasis added). The term comprising is open-ended and does not exclude any unrecited steps. MPEP § 2111.03. Therefore the presence of a stripping step prior to filtration does not differentiate the claimed invention from the prior art.

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B) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

C) Applicant's argument that Ageishi et al. and Schlosberg et al. teach adding the absorbent at different points of the process is not persuasive. Schlosberg teaches treating with the absorbent either before the purification or "later in the process following either flash drying or steam or nitrogen stripping" (5:56-61). A person having ordinary skill in the art at the time of invention would have looked to Scholsberg et al. as it teaches adding an absorbent in the same point of the process as Ageishi et al in certain embodiments.

D) In response to applicant's argument that Ageishi et al. and Scholsberg et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ageishi et al. and Schlosberg et al. are combinable because they are from the same field of endeavor, namely that of processes for making plasticizer esters.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796

LJH

March 19, 2008

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